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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,151	07/23/2003	Glen J. Anderson	ACER-45197	7986
116 7590 09/28/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,151

Applicant(s)

ANDERSON ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 23 and 34-45 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 23, 34-42, and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. § 1.114

1. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 June 2009 has been entered.

Acknowledgements

2. This action is responsive to Applicants' above noted RCE and associated amendments received 15 June 2009.
3. This action has been assigned paper number 20090917 for reference purposes only.
4. Claims 1-6, 23, and 34-45 are pending.
5. Claims 43 and 45 are withdrawn.
6. Claims 1-6, 23, 34-42, and 44 have been examined.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6, 23, and 34-42 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites “sending the product code to be delivered to the electronic device” which renders the claim indefinite. The phrase “sending the product code” implies that the product code is sent to the electronic device such that the electronic device receives the product code. However, the phrase “to be delivered to the electronic device” implies that the product code has not reached the electronic device. Because of these conflicting phrases in this limitation, one of ordinary skill in the art would not understand whether the product codes are received by the electronic device or if they just have to be sent out with intent to be received by the electronic device.

10. Because of the uncertainty in the delivery of the product code to the electronic device, it is also uncertain if the limitation “wherein the product code, in response to being delivered to the electronic device, converts the product from the disabled state to an enabled state that enables use of the previously purchased product on the electronic device, said previously purchased product not being usable on the electronic device until being enabled with the product code” is performed. If the delivery of the product code to the electronic device is only intended, it does not necessarily happen. Therefore, the actions to be performed “in response to being delivered to the electronic device” would not happen either.

11. Claim 23 contains a similar limitation and is rejected under the same basis.

12. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Claim 23 is rejected under 35 U.S.C. 101 because the claim is directed to neither a “process” nor a “machine” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C 101 which is drafted so as to set the statutory classes of invention in the alternative only. For examination purposes, the examiner will interpret this claim as directed to a method only.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-3, 5, 6, 23, 34-36, 38-42, and 44 rejected under 35 U.S.C. 102(b) as being anticipated by Huges (US 2001/0044782).

18. As to claims 1 and 23, Hughes shows:

- a. A method comprising:
- b. receiving a request ("PID + H/W ID," Figure 2) transmitted over a communication network 336 from an electronic device 20 operatively connected to the communication network (communication occurs through the network, [0041]) requesting a product code ("license file," Figure 2; 118) for a previously purchased product 222 that was purchased and provided ("Install," Figure 2) to the electronic device in a disabled state before the request was transmitted (product is enabled when the calculated license matches the received license, [0043], wherein the request includes an identification from the electronic device ("PID" product identifier and "H/W ID" hardware identifier, Figure 2);
- c. finding a product code associated with the identification ("The activation unit 110 checks the database 114 for any prior records involving the product ID," [0054]; Database 114 contains table 116 which includes PID, H/W ID, and License file, Figure 2);
- d. retrieving the product code associated with the identification from a database of product codes ("the activation unit 110 evaluates the hardware IDs associated with the product Ids, Id.);
- e. responsive to said retrieving, sending the product code to be delivered to the electronic device (Figure 2 & "the activation unit will compute a new license file, return it to customer computer," [0054]);
- f. wherein the product code, in response to being delivered to the electronic device, converts the product from the disabled state to an enabled state that enables use of the

previously purchased product on the electronic device (product is enabled when the calculated license matches the received license, [0043]), said previously purchased product not being usable on the electronic device until being enabled with the product code (Id.).

19. As to claim 2, Hughes further shows:

g. copying the product code to a database **114** when the product is purchased, the copying the product code to the database including associating the product code with the identification in the database (Database 114 contains table 116 which includes PID, H/W ID, and License file, Figure 2).

20. As to claim 3, Hughes further shows:

h. the finding the product code further comprises finding the product code in the database using the identification of the received request ("PID" and "H/W ID" are used, [0054]).

21. As to claim 5, Hughes further shows:

i. the identification identifies the electronic device ("H/W ID" [0015]).

22. As to claim 6, Hughes further shows:

- j. the identification identifies a customer (identifying the customer's electronic device also identifies the customer indirectly).

23. As to claim 34, Hughes further shows:

- k. sending the product code and the identification to a server when the product is purchased [0032] – [0034]; and
- l. copying the product code and the identification to a database on the server (“the customer registers the software product with the activation authority,” [0034]).

24. As to claim 35, Hughes further shows:

- m. retrieving the product code from the server to enable use of the product on the electronic device when the product is reinstalled on the electronic device [0047].

25. As to claim 36, Hughes further shows:

- n. inserting the product code into an installation routine for reinstalling the previously purchased product to enable use of the product on the electronic device [0047].

26. As to claim 38, Hughes further shows:
- o. the request for the product code is sent by the electronic device during an attempt to install the product on the electronic device [0016].
27. As to claim 39, Hughes further shows:
- p. the request for the product code is sent by the electronic device as a part of an installation process to install the product on the electronic device [0016].
28. As to claim 40, Hughes further shows:
- q. the request by the electronic device is transmitted (Figure 2) over a network **336**, and the product code is sent over the network to the electronic device (Figure 2).
29. As to claim 41, Hughes further shows:
- r. the product was previously loaded on the electronic device making the request, and the request for the product code is made as part of a reinstallation process for the product on the electronic device [0047].
30. As to claim 42, Hughes further shows:
- s. the sending of the product code does not include sending the product for which the product code enables use (Figure 2).

31. As to claim 44, Hughes further shows:

- t. An apparatus **334** comprising:
 - u. a controller including a processor (inherent for a server to perform anything); and
 - v. a storage device (inherent to the existence of software on the server), wherein the storage device includes instructions (**110**, [0035]) , which when executed on the processor cause the controller to:
 - i. receive a request (“PID + H/W ID,” Figure 2) from an electronic device **20** transmitted over a communication network **336** requesting a product code (“license file,” Figure 2; 118) for a previously purchased product **222** in response to installation (“Install,” Figure 2) or reinstallation [0047] of the product on the electronic device, the request including an identification PID” product identifier and “H/W ID” hardware identifier, Figure 2) from the electronic device and being received by the controller in response to installation or reinstallation of the product onto the electronic device by the user (Figure 2);
 - ii. in response to receiving the request, find and retrieve a product code associated with the identification (“The activation unit 110 checks the database 114 for any prior records involving the product ID,” [0054]; Database 114 contains table 116 which includes PID, H/W ID, and License file, Figure 2); and
 - iii. send the product code that was retrieved in response to receiving the request to the electronic device over the communication network to be inserted into an installation routine during installation or reinstallation of the product (Figure 2 & “the activation unit will compute a new license file, return it to

customer computer,” [0054]) and convert the product from a disabled state in which the product is not usable on the electronic device into an enabled state in which the product is usable on the electronic device (product is enabled when the calculated license matches the received license, [0043]).

Claim Rejections - 35 USC § 103

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 4 and 37 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes in view of Flickinger (US 2001/0025245).

34. Hughes shows as discussed above in regards to claim 1 and further shows:

- w. loading the product code for the product onto the electronic device [0043]; and
- x. copying the product code and the identification associated with the product code to a database to permit future retrieval of the product code using the identification [0054].

35. Hughes does not expressly show:

- y. copying the product code to a database when the product and the electronic device are purchased; or
- z. loading the product onto the electronic device by a manufacturer of the electronic device;

36. However, Flickinger shows a purchaser providing information at purchase so the manufacturer can register an item and provide the registration information to the purchaser [0039]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Hughes to have the electronic device manufacturer perform the registration normally performed by the purchaser. This would take the burden of completing the registration, warranty, and any other forms off the purchaser [0039].

37. Claim 44 is alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of Stanfield (Linux System Administration).

38. While it is the Examiner's principle position that a processor and memory are inherent to an authentication server, the Examiner provides the following, alternate, grounds of rejection in case a reviewing body disagrees.

39. As to claim 44, Hughes shows:

aa. An apparatus **334** comprising:

bb. instructions (110, [0035]) , which when executed on the processor cause the controller to:

iv. receive a request ("PID + H/W ID," Figure 2) from an electronic device **20** transmitted over a communication network **336** requesting a product code ("license file," Figure 2; 118) for a previously purchased product **222** in response to installation ("Install," Figure 2) or reinstallation [0047] of the product on the electronic device, the request including an identification PID" product identifier and "H/W ID" hardware identifier, Figure 2) from the electronic device and being

received by the controller in response to installation or reinstallation of the product onto the electronic device by the user (Figure 2);

v. in response to receiving the request, find and retrieve a product code associated with the identification (“The activation unit 110 checks the database 114 for any prior records involving the product ID,” [0054]; Database 114 contains table 116 which includes PID, H/W ID, and License file, Figure 2); and

vi. send the product code that was retrieved in response to receiving the request to the electronic device over the communication network to be inserted into an installation routine during installation or reinstallation of the product (Figure 2 & “the activation unit will compute a new license file, return it to customer computer,” [0054]) and convert the product from a disabled state in which the product is not usable on the electronic device into an enabled state in which the product is usable on the electronic device (product is enabled when the calculated license matches the received license, [0043]).

40. Hughes does not expressly show:

- cc. a controller including a processor; and
- dd. a storage device.

41. However, Stanfield shows a Pentium III or AMD Athlon processor and a 10 GB SCSI hard drive as being necessary components in "A Basic Server" (Page 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Hughes, to include a processor and storage in the server, if not already there. A processor is needed in a server to perform calculations and the storage is needed to store the values used in the calculations and the results.

Response to Arguments

42. Applicant's arguments with respect to claims 1-6, 23, 34-42, and 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

44. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621